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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/600,322	07/14/2000	KATSUHIKO HIRAMATSU	JEL31215	1555

7590 03/18/2004

STEVENS DAVIS MILLER & MOSHER
1615 L STREET NW SUITE 850
WASHINGTON, DC 20036

EXAMINER

MOORE, JAMES K

ART UNIT	PAPER NUMBER
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2686

12

DATE MAILED: 03/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/600,322

Applicant(s)

HIRAMATSU ET AL.

Examiner

James K Moore

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2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 July 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 21, 2003 has been entered.

Response to Arguments

2. Applicant's arguments filed October 21, 2003 have been fully considered but they are not persuasive.

The applicant argues that Gilhousen does not disclose a base station apparatus that can individually detect a position of a communication terminal apparatus. See page 8 of the arguments. However, the examiner disagrees. Gilhousen discloses a method of detecting the position of a communication terminal apparatus with a single base station in col. 9, lines 5-55.

The applicant also argues that Gilhousen fails to disclose that the transmit power controller of a base station changes a target quality to a level provided by a control station and performs transmit power control with respect to the communication terminal at the target quality in response to a determination that position detection is being performed during a diversity handover. See page 8 of the arguments. However, this

claimed limitation was not disclosed in the applicant's specification and is therefore rejected under 35 U.S.C. 112, 1st paragraph, as explained below.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 8-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 8 includes the limitation "a second notifier that notifies the control station apparatus of second information to the effect that a position detection is in progress." However, the specification does not disclose a notifier in a base station apparatus that notifies a control station apparatus that a position detection is in progress.

Claim 8 also includes the limitation "a receiver that receives third information provided from the control station apparatus to the effect that, in response to a determination that said position detection is being performed during said diversity handover, a target quality is to be changed to a level provided from the control station apparatus to enable satisfactory performance of said position detection." The

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specification discloses a receiver that receives information from a control station apparatus that causes a target quality to be changed to a level to enable satisfactory performance of position detection. See, e.g., page 8, line 15 – page 9, line 5 of the specification. However, the specification does not disclose that the information is received in response to a determination that position detection is being performed during a diversity handover. Instead, the information is received in response to a determination that a mobile station is in a diversity handover state. See, e.g., page 8, lines 15-23.

Claim 9 includes the limitation “a target quality changer that raises a target quality in response to determination that a position detection is being performed during said handover.” However, the specification does not disclose that the target quality is raised in response to a determination that position detection is being performed during a handover. Instead, the target quality is received in response to a determination that a mobile station is in a diversity handover state. See, e.g., page 15, lines 19 – page 16, line 13.

Claim 12 includes the limitation “providing, from a base station apparatus to a control station apparatus, ... second information to the effect that a position detection is in progress.” However, the specification does not disclose that a base station apparatus provides a control station apparatus with information regarding a position detection in progress.

Claim 12 also includes the limitation “providing, from the control station apparatus to the communication terminal apparatus and the base station apparatus,

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third information to the effect that, in response to a determination that the position detection is being performed during the diversity handover, a target quality is to be changed to a level provided from said control station apparatus to enable satisfactory performance of said position detection." However, the specification does not disclose that the information regarding the target quality is provided in response to a determination that a position detection is being performed during a diversity handover.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ken Moore, whose telephone number is (703) 308-6042. The examiner can normally be reached on Monday-Friday from 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold, can be reached at (703) 305-4379.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Ken Moore

JKM

3/10/04

Marsha D Banks-Harold

MARSHA D. BANKS-HAROLD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600